

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 17-36 and 38-44 are currently pending. Claims 20, 21, and 23 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 17-28, 31-36, and 41-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0236836 to Borthwick (hereinafter “the ‘836 publication”) and U.S. Patent No. 5,805,783 to Ellson (hereinafter “the ‘783 patent”); and Claims 29-30 and 38-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘836 publication, the ‘783 patent, and Khare (“Bitstream portable font resources for Web pages,” 20 February 1997, retrieved from <http://www.xent.com/FoRK-archive/winter96/0524.html> on 1 May 2009) (hereinafter “the Khare article”).

Applicants’ Claim 17 is directed to a 3D character mail system for reproducing electronic mail, comprising in part:

a first terminal to create 3D character mail, to generate instruction information for expressing an input text message using a 3D font, and to transmit the text message and instruction information to a server;

said server to store a 3D font, ***to generate control information about the 3D font for expressing the text message on the basis of the received instruction information***, and to store the received text message and the generated control information as 3D message information. [Emphasis Added]

The Office Action associates the claimed server with a host server (120) and a web site (130), as described in the ‘836 publication stating that the animation menu in the ‘836 publication is downloaded from the host server (120) since the writer template is a

downloaded copy of the writer on the host server (120).¹ Further, the Office Action asserts that since it is implied that the host server (120) produces the copy of the animation menu which is downloaded, the host server (120) generates control information (about a 3D font) is taught.²

Applicants respectfully traverse the above assertion of the Office Action, and submit that, assuming *arguendo* that a download source of the animation menu, which is a tool of specification of the animation, is the host server 120, the specification of the animation is performed in a writer computer (110).³

Therefore, in the '836 publication, host server (120) is merely the download source of the writer template (100) that is a tool for writer computer (110), which would appear to correspond to the claimed first terminal, to generate the control information. There is *no* disclosure in the '836 application that the server host (120) generates control information for expressing a text message, input in the writer computer (110) on the basis of received instruction information.

Thus, the '836 publication does not disclose or suggest the a server to generate control information about the 3D font for expressing the text message (input in the first terminal) on the basis of the received instruction information (received from the first terminal), as recited in Claim 17.

Further, the '783 patent is simply directed to storing three-dimensional font characters and retrieving them to be manipulated, using conventional-type setting manipulations as well as orientation manipulations of the text in three dimensions. Thus, Applicants respectfully submit that the '783 publication fails to overcome the deficiencies of the '836 patent.

¹ See Office Action dated November 13, 2009, page 5.

² *Id.* at page 6.

³ See the '836 publication, paragraph [0037].

Therefore, Applicants respectfully submit that no matter how the '836 patent and the '783 publication are combined, the combination fails to teach or suggest the above discussed feature in Claim 17.

Please note that the above discussion regarding independent Claim 17 also applies to independent Claim 19, which recites analogous features in a claim of a different scope.

Thus, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of independent Claims 17 and 19 (and all associated dependent claims) be withdrawn.

Applicants' Claim 20 is directed to a 3D character mail system for reproducing electronic mail, comprising, in part:

a first terminal to create 3D character mail, to generate control information about a 3D font for expressing an input text message, and to transmit the text message and the generated control information to a second terminal without transmitting information related to the 3D character mail to a server.

Support for the amendments to Claim 20 is found in the originally filed specification.⁴

In regard to the first terminal transmitting text message and generated control information to a second terminal, as recited in Claim 20, the Office Action cites paragraphs 0026, 0028, and 0056 of the '836 publication. Applicants respectfully submit that the cited paragraphs of the '836 publication describe creating a rich media production on the author terminal, and, upon sending an email to a recipient of the rich media production, sending a session file and a variables file to a host.

Thus, Applicants respectfully submit that the '836 publication fails to disclose or suggest a first terminal to create 3D character mail, to generate control information about a 3D font for expressing an input text message, and to transmit the text message and the generated control information to a second terminal without transmitting information related to the 3D character mail to a server, as recited in amended Claim 20.

⁴ Specification at pages 15 and 16 and Fig. 3.

Further, the Office Action states that, in the '836 publication, a reader template (146) on a recipient computer (140) accesses and reads the data string of the rich media production from the host server (120), and on the basis of the same, the Office Action asserts the teaching of the claimed the second terminal to specify the font necessary for reproducing the character mail on the basis of the text message and the control information.⁵

However, Applicants submit that in Claim 20, the first terminal transmits the text message and the control information to the second terminal (not to the server); and the second terminal receives the text message and the control information from the first terminal (not from the server) and downloads the 3D font from the server. Accordingly, the teachings in the '836 publication differs from the Claim 20 in that the reader template (146) on the recipient computer (140), which appears to correspond to the second terminal, accesses and downloads the whole set of the rich media production from the host server (120).

Thus, Applicants submit that the '836 publication fails to disclose or suggest the above discussed features of Claim 20.

Finally, Applicants respectfully submit that, as discussed above, the '783 publication fails to overcome the deficiencies of the '836 patent.

Therefore, Applicants respectfully submit that no matter how the '836 patent and the '783 publication are combined, the combination fails to teach or suggest the above discussed features recited in Claim 20.

Thus, it is respectfully requested that the 35 U.S.C. § 103(a) rejection of independent Claim 20 (and all associated dependent claims) be withdrawn.

Claim 21 is directed to a 3D character mail system for reproducing electronic mail, comprising, in part:

⁵ See Office Action dated November 13, 2009, page 7.

said second terminal to reproduce the 3D character mail only on the basis of the text message, the control information and the 3D font received from said first terminal.

Support for the amendments to Claim 21 is found in the originally filed specification.⁶

In regard to the above cited portion of Claim 21, the Office Action cites paragraph 0059 of the '836 publication, which describes that, when a recipient computer receives an email containing URLs for downloading a copy of the reader template and importing media components of a rich media production, the recipient computer also "accesses and reads the unique data string from the host server." Thus, in the system of the '836 publication, in addition to the email contents, the recipient computer also obtains information from a host server to display the rich media production.

Applicants respectfully submit that the '836 publication fails to disclose or suggest a said second terminal to reproduce the 3D character mail **only** on the basis of the text message, the control information and the 3D font received from said first terminal, as recited in amended Claim 21.

Applicants respectfully submit that, as discussed above, the '783 publication fails to overcome the deficiencies of the '836 patent.

Therefore, Applicants respectfully submit that no matter how the '836 patent and the '783 publication are combined, the combination fails to teach or suggest a said second terminal to reproduce the 3D character mail only on the basis of the text message, the control information and the 3D font received from said first terminal, as recited in amended Claim 21.

Thus, it is respectfully submitted that the rejections of independent Claim 21 (and all associated dependent claims) are rendered moot by the present amendment.

⁶ Specification at page 17, lines 4-6 and Fig. 4.

Independent Claim 23 recites limitations analogous to the limitations in Claim 21, except for the transmission of a 3D font, and Claim 23 has been amended in a manner analogous to the amendments to Claim 21. Thus, for the reasons stated above with respect to Claim 21, Applicants respectfully submit that the rejections of independent Claim 23 (and all associated dependent claims) are rendered moot by the present amendment.

Regarding the rejection of Claims 29-30 and 38-40 under 35 U.S.C. §103, Applicants respectfully submit that the Khare article fails to remedy the deficiencies of the combination of the '836 publication and the '783 patent, as discussed above. Thus, applicants respectfully submit that the rejections of the above noted dependent claims are rendered moot by the present amendment to Claims 17, 19-21, and 23.

Thus, it is respectfully submitted that independent Claims 17, 19-21, and 23 (and all associated dependent claims) patentably define over any proper combination of the cited references.

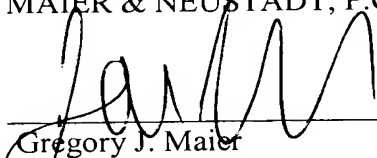
Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)



Gregory J. Maier
Attorney of Record
Registration No. 25,599

James J. Kulbaski
Registration Number 34,648